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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/469,253 12/22/99 NAKAMURA N 0230-0145P

002292 HM12/0228
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EXAMINER

WANG, A

ART UNIT	PAPER NUMBER
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1635

6

DATE MAILED:

02/28/00

OK Docketed
5-28-00
Amended

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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APPL COPY

Office Action Summary

Application No.
09/469,253Applicant(s)
Nakamura et al.Examiner
Andrew WangGroup Art Unit
1635☒ Responsive to communication(s) filed on Dec 22, 1999☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 11 and 12 is/are allowed.☒ Claim(s) 10 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.☒ received in Application No. (Series Code/Serial Number) 08/669,286.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Applicants request to transfer the sequence listing, filed December 22, 1999, from parent application, 08/669,286, has been received and entered into the instant application.
2. Applicants drawings filed December 22, 1999, have been approved and entered.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al. (JBC, vol. 266 (7), pages 4581-4585).

The invention of the above claim is drawn to an isolated adseverin protein having SEQ ID NO: 5.

Sakurai discloses an isolated protein having a molecular weight of 74 kDa isolated from bovine and having the claimed adseverin activity. Moreover, the isolated protein disclosed by Sakurai, was cleaved into two fragments (42kDa and 39kDa) when digested with V8 protease and trypsin, which is identical to results as shown in the specification. Although Sakurai does not

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disclose the peptide sequence of the isolated adseverin protein, said sequence would be inherent since it appears that protein disclosed by Sakurai is identical to that disclosed by applicants.

Therefore, the invention of the above claim is anticipated by Sakurai et al.

4. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al. JBC, vol. 266 (24), pages 15979-15983).

The invention of the above claim is drawn to an isolated adseverin protein having SEQ ID NO: 5.

Sakurai discloses an isolated protein having a molecular weight of 74 kDa isolated from bovine and having the claimed adseverin activity. Moreover, the isolated protein disclosed by Sakurai, was cleaved into two fragments wherein the amino half was 42kDa when digested with V8 protease and trypsin, which is identical to results as shown in the specification. Although Sakurai does not disclose the peptide sequence of the isolated adseverin protein, said sequence would be inherent since it appears that protein disclosed by Sakurai is identical to that disclosed by applicants.

Therefore, the invention of the above claim is anticipated by Sakurai et al.

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Del Castillo et al.

The invention of the above claim is drawn to an isolated adseverin protein having SEQ ID NO: 5.

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Del Castillo discloses an isolated scinderin protein having a molecular weight of 79.6 kDa and actin severing activity identical to the claimed adseverin protein. Although the protein disclosed by Del Castillo has a different nomenclature and molecular weight, it is believed to be the same protein as that disclosed by applicants and Sakurai, as noted above, since Sakurai clearly states that it also known as scinderin and further cites Del Castillo (see page 4581, first paragraph). Although Del Castillo does not disclose the peptide sequence of the isolated scinderin protein, said sequence would be inherent since it appears that protein disclosed by Del Castillo is identical to that disclosed by applicants.

Therefore, the invention of the above claim is anticipated by Del Castillo et al.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the culture supernatant of" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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Claim 10 is vague and indefinite since it cannot be determined whether the culture supernatant is obtained from the transformed cells or from a culture of transformed cells. It is recommended that applicants rewrite claim 10 as follows to obviate any 35 U.S.C. 112, second paragraph rejections:

--10. A recombinant adseverin protein isolated and purified from [the] a culture supernatant [of] obtained [by incubating] from a prokaryotic or eukaryotic host cell culture transformed by a recombinant vector containing an isolated DNA containing a base sequence encoding an amino acid sequence represented by SEQ ID NO: 5 or 7.--

7. Claims 11 and 12 are allowed.

8. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Page 31 discloses nucleotide sequence which are not identified by SEQ ID NO:.. Applicants should the review the application to find any additional sequences not referred to by SEQ ID NO:..

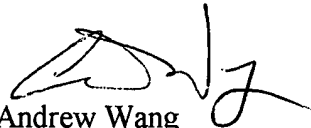
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Applicant is given THREE MONTHS from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Wang whose telephone number is (703) 306-3217. The examiner can normally be reached on Monday to Thursday from 7:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Andrew Wang
February 25, 2000